

Agilent Ref: 10031188 - 1  
United States Application Serial No. 10/782,269

## **RESPONSE**

### **Formal Matters**

Claims 1-5, 8-30 and 37-44 are pending after entry of the amendments set forth herein.

Claims 1-5, 8-18, 28-30 and 37 were examined and rejected.

Claim 1 and 37 are amended for clarity. No new matter is added.

### **Rejection under 35 U.S.C. §112, second paragraph**

Claim 1 is objected to because it is assertedly unclear as to whether the analytes of element b) and the sample of element a) have any connection.

Claim 1 has been amended.

The Applicants submit that this rejection has been addressed. Withdrawal of this rejection is respectfully requested.

### **Rejection under 35 U.S.C. §102**

Claims 1 - 5, 10 - 15, 17, 18 and 37 are rejected as anticipated by Little (U.S. Pat. No. 6,387,628).

It is well established, however, that in order to anticipate a claim, a reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil of California*, 2USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.

According to Little's col. 50, the array employed in Little's methods is a "pin array", i.e., an array in which capture agents are attached to the ends of pins.

A pin array is not a planar substrate having a surface on which said features are positioned.

Since the claims requires the use of a planar substrate having a surface on which said features are positioned, the Applicants submit that Little fails to disclose each and every element of the rejected claims, and, as such, this rejection should be withdrawn.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

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**Rejection under 35 U.S.C. §103 – Little in view of Marshall**

Claim 8 has been rejected under 35 U.S.C. §103 (a) as being unpatentable over Little in view of Marshall.

As noted above, Little is deficient for failing to disclose each and every element of the claims. Specifically, Little does not disclose the use of a planar array.

Marshall is cited solely to provide a “washing” step. Thus, Marshall fails to make up the deficiency of Little.

In view of the above, the Applicants submit that Little and Marshall, taken alone or in combination, do not teach or suggest each and every element found in the claims.

In view of the foregoing discussion, withdrawal of this rejection is respectfully requested.

**Rejection under 35 U.S.C. §103 – Little in view of Krantz**

Claim 9 has been rejected under 35 U.S.C. §103 (a) as being unpatentable over Little in view of Krantz.

As noted above, Little is deficient for failing to disclose each and every element of the claims. Specifically, Little does not disclose the use of a planar array.

Krantz is cited solely to provide a “crystallization” step. Thus, Krantz fails to make up the deficiency of Little.

In view of the above, the Applicants submit that Little and Krantz, taken alone or in combination, do not teach or suggest each and every element found in the claims.

In view of the foregoing discussion, withdrawal of this rejection is respectfully requested.

**Rejection under 35 U.S.C. §103 – Little in view of El Shami**

Claim 16 has been rejected under 35 U.S.C. §103 (a) as being unpatentable over Little in view of El Shami.

As noted above, Little is deficient for failing to disclose each and every element of the claims. Specifically, Little does not disclose the use of a planar array.

El Shami is cited solely to provide a step in which the amount of an analyte is determined. Thus, El Shami fails to make up the deficiency of Little.

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In view of the above, the Applicants submit that Little and El Shami, taken alone or in combination, do not teach or suggest each and every element found in the claims.

In view of the foregoing discussion, withdrawal of this rejection is respectfully requested.

**Rejection under 35 U.S.C. §103 – Little in view of Sugiyama**

Claim 16 has been rejected under 35 U.S.C. §103 (a) as being unpatentable over Little in view of Sugiyama.

As noted above, Little is deficient for failing to disclose each and every element of the claims. Specifically, Little does not disclose the use of a planar array.

Sugiyama is cited solely to provide a data transmission step. Thus, Sugiyama fails to make up the deficiency of Little.

In view of the above, the Applicants submit that Little and Sugiyama, taken alone or in combination, do not teach or suggest each and every element found in the claims.

In view of the foregoing discussion, withdrawal of this rejection is respectfully requested.

**Obviousness-type double patenting**

Claims 1-6, 8-18, 28-30 and 37 are provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of co-pending patent application 10/001,493.

The Applicants respectfully request that this rejection be held in abeyance until a Notice of Allowance is received for one of the co-pending applications.

Since this rejection is provisional, this request is appropriate.

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**Conclusion**

The Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

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